

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SIYUJITI SAKAMOTO, KAZUMI TAKEISHI,
HIROAKI ORIKASA and TAKAHIKO SHIMADA

Appeal No. 96-3039
Application 08/284,210¹

ON BRIEF

MAILED

OCT 30 1996

**PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before MEISTER, HAIRSTON, and McQUADE, Administrative Patent
Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed August 2, 1994.

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Application 08/284,210

This appeal is from the final rejection of claims 2 through 7. Claims 8 and 9, the only other claims pending in the application, stand allowed.

The subject matter on appeal pertains to a pipe cutting assembly comprising a vise in the form of a pipe wrench for clamping a pipe and a saber saw coupled to the vise for cutting it. Claim 2 is illustrative and reads as follows:²

2. A saber saw assembly comprising:

a vice for clamping an object to be cut; and

a saber saw having a saw blade to be operated in reciprocating motion, said saber saw cutting said object with the reciprocating saw blade while said object is clamped by said vice;

wherein said vice is in the form of a pipe wrench;

wherein said vice clamps said object when rotated in a clamping direction and releases said object when rotated in a releasing direction; and

wherein said saber saw is coupled to said vice so as to apply a force to said vice in said clamping direction when said saber saw is displaced relative to said vice for cutting said object.

² The term "vice" as used in claim 2 and throughout the rest of the instant application is understood to be a synonym for the more conventionally employed term --vise--.

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The references relied upon by the examiner as evidence of obviousness are:

Roche	2,227,844	Jan. 7, 1941
Calello	2,748,641	Jun. 5, 1956
Smeltzer et al. (Smeltzer)	3,834,019	Sep. 10, 1974

The appealed claims stand rejected under 35 U.S.C. § 103 as follows:

a) claims 2 through 6 as being unpatentable over Smeltzer in view of Calello; and

b) claim 7 as being unpatentable over Smeltzer in view of Calello, and further in view of Roche.

Smeltzer discloses an assembly 10 for cutting tubes or pipes of the type found in the exhaust system of an automobile. The assembly comprises a conventional saber saw tool 12 and an attachment 30 "for facilitating the positioning of exhaust system tubes of different sizes in operative relation with the cutting blade and the cutting movement of the blade therethrough" (column 1, lines 7 through 10). The attachment includes

a tube engaging structure [32] pivotally mounted on the housing [14] on the tool for movement with respect thereto between a tube receiving position [Figure 1] and a cutting cycle completion position [Figure 2], a

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handle [36] for enabling the operator to effect manual movement of the structure into the tube receiving position, the structure providing a tube receiving recess [38] therein open in a direction toward the cutting teeth and free end of the blade [22] when the structure is moved into the tube receiving position thereof so as to position the structure in operative relation with a tube and a spring [40] connected with the structure for effecting a resiliently biased movement thereof from the tube receiving position into the cutting cycle completion position upon the manual release of the handle with a tube disposed in operative relation between the recess and the cutting blade so that the operative movement of the blade will transversely cut the tube during the aforesaid resiliently biased movement of the structure without engagement of the handle permitting the operator to support portions of the exhaust system which are cut during the operation [Abstract].

The foregoing assembly does not meet the limitations in independent claim 2 requiring a "vice" in the form of a pipe wrench which is coupled to a saber saw so as to apply a clamping force to the "vice" when the saber saw is displaced relative to the "vice" for cutting.

Calello discloses a typical pipe wrench.

According to the examiner,

[i]t is well known that pipe wrenches security [sic, securely] hold pipes as taught by Calello. Thus, a pipe wrench would hold pipes as effectively as the complex structure of Smeltzer. Thus one of ordinary skill in the art would obviously replace the holder of Smeltzer with the wrench of Calello. The wrench may be pivoted in the manner of Smeltzer's clamp [answer, page 3].

The teachings of Smeltzer and Calello, however, do not justify the examiner's conclusion that it would have been obvious to one of ordinary skill in the art to combine them in this manner. Smeltzer's attachment 30, which is not all that complex, functions to bias the tube being cut and the saber saw blade into operative engagement with one another. While the artisan certainly would have appreciated that a typical pipe wrench such as that disclosed by Calello is capable of securely holding a pipe or tube, a pipe wrench would not, in and of itself, provide the desired biasing action of Smeltzer's attachment. Thus, it is not apparent why one of ordinary skill in the art would have found any suggestion in the common knowledge relating to pipe wrenches to replace Smeltzer's attachment with such a tool, or to couple it to the saber saw in the particular manner recited in

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claim 2. Calello's specific teachings are also lacking in this regard. In short, the examiner has engaged in an impermissible hindsight reconstruction of the appellants' invention using the claims as a template to piece together isolated disclosures in the prior art.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 2, or of claims 3 through 6 which depend therefrom, as being unpatentable over Smeltzer in view of Calello.


Since Roche does not cure the noted deficiency in the basic Smeltzer-Calello combination, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 7, which depends from claim 5, as being unpatentable over Smeltzer in view of Calello, and further in view of Roche.


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The decision of the examiner is reversed.


REVERSED


JAMES M. MEISTER
Administrative Patent Judge


KENNETH W. HAIRSTON
Administrative Patent Judge

BOARD OF PATENT

APPEALS AND


JOHN P. McQUADE
Administrative Patent Judge

INTERFERENCES

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COMMUNICATION

MAILED

OCT 30 1996

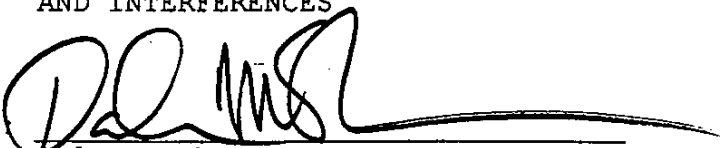
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BOARD OF PATENT APPEALS
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On October 16, 1996, Mr. Dale M. Shaw, a Program and Resource Administrator at the Board of Patent Appeals and Interferences, and Mr. Marc A. Rossi, Registration No. 31,923 had a telephone conversation. During this conversation, Mr. Shaw invited appellants' counsel to waive the oral hearing. Mr. Rossi agreed stating that if the decision was in the examiner's favor, that he would refile the application.

Accordingly, the Oral Hearing in this application has been waived.

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AND INTERFERENCES

By


Dale M. Shaw
Program and Resource Administrator
703-308-9797

¹ This application was filed on August 2, 1994.

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cc: Rossi & Associates
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